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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/445,175	03/14/2000	DANIEL RICHARD SCHNEIDEWEND	RCA89037	9591

7590 08/26/2003

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EXAMINER

GRANT, CHRISTOPHER C

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 08/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/445,175

Applicant(s)

SCHNEIDEWEND ET AL.

Examiner

Christopher Grant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-8 and 12-16 is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (5,585,866) (provided by applicant) in view of Tsumura et al (Tsumura).

Considering claims 1 and 9, Miller discloses an apparatus for processing a first type of program having both audio and video content and a second type of program having audio-only content comprising:

(a) a memory storing display information representing one or more images (icon, text, title, artist, record company name etc. col. 31, lines 4-46);

(b) means (31,29, 28,16, figure 1) for selecting a program (audio-video program or music); and

(c) a control means (16, figure 1) for determining a type of program of the selected program,

if the control means determines that the selected program is first type of program (audio-video program), then the control means causes playing of the audio content and displaying of the video content associated with the selected program (see selecting of pay-per-view movie at col. 18, lines 26-67 or selecting of NVOD at col. 32, lines 9-43 and col. 28, line 61 – col. 30, line 22),

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if the control means determines that the selected program is a second type of program (DMX channels 41-46), then the control means causes playing of the audio-only content (music) associated with the selected program and displaying of stored the image (see placement of icon or text indicating that the Listen function has been activated at col. 31, lines 14-18 or displaying title, artist, record company name etc. of the music currently being played at col. 31, lines 24-46) (see all references to DMX and NVOD selections in columns 28-31).

Although Miller discloses a memory storing images to be displayed when music is selected or activated (col. 31, lines 4-46), he fails to specifically disclose a memory storing display information representing an animated image as recited in the claim.

Tsumura discloses an apparatus comprising a memory (6) for storing display information representing animated image and displaying an audio program with the animated image for the advantage of providing visual enjoyment with music to users. In particular, animated images provides more enjoyment over still images. See abstract, col. 1, line 29-45 and col. 2, lines 3-21, 51-64.

It would have been obvious to one of ordinary skill in the art to modify Miller's system to include any type of visual information such as animation, as taught by Tsumura, for the advantage of providing visual enjoyment.

Claims 2 and 10 are met by the combined systems of Miller and Tsumura, wherein Miller discloses that the program guide information includes the audio-only channels as illustrated in figures 43-47 and described in columns 29-31. Therefore, the control means determines the type of program by selecting any one of the audio only program from the screens in figure 43-47.

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As for claims 3 and 11, the combined systems of Miller and Tsumura fail to specifically disclose displaying the program guide information along with the animated image as recited in the claims.

It would have been obvious to one of ordinary skill in the art to modify the combined systems of Miller and Tsumura to include displaying the program guide information along with the animated image because it is typical to display additional information on a guide/general help screen to help or instruct the user to make better decisions.

Claim 4 is met by the combined systems of Miller and Tsumura, since moving images do not burn the phosphor or the display elements on a display screen/monitor (i.e. screen saver).

Allowable Subject Matter

3. Claims 5-8 and 12-16 are allowed because the prior art fails to disclose or suggest an apparatus and corresponding method for processing a first type of program having audio-video content and a second type of program having audio only content, and when a control means determines that a selected program is first type, playing the audio content and displaying the video content and when the control means determines that a selected program is a second type and animation is selected, the control means causes playing of the audio only program and displaying stored animation, and when animation is not selected, the control means causes playing of the audio only program and displaying a static image as recited in the claims.

Response to Arguments

4. Applicant's arguments filed 5/30/2003 have been fully considered but they are not persuasive.

Response to Applicant's arguments.

a) Applicant argues that "...Miller **does not** provide "a control means for determining a type of program of the selected program; and based on the determining, ..." Instead, Miller displays various information for the music channels before they are even "**selected**" on page 8, lines 9-12 of amendment filed 5/30/2003.

In response, the Examiner totally disagrees. First, Miller discloses a controller (16) that determines if an audio-video program (pay-per-view or NVOD) is selected and then causes playing of the audio and displaying of an associated video. A determination is made because the controller (16) distinguishes (by the channel selected) what type of program is selected. See the entire reference including but not limited to col. 10, lines 15-22, col. 28, line 62 – col. 30, line 10 and col. 32, lines 9-61.

Secondly, Miller discloses a controller (16) that determines if an audio-only content (music) is selected and displaying of the audio-only content and displaying of a stored image. See col. 29, line 30 - col. 31, line 46.

Thirdly, Miller discloses displaying images **after** a music channel is selected. Col. 31, lines 14-17 disclose "***An appropriate indicator...or placement of an appropriate icon or text, indicating that the Listen function 503 has been activated***".

Fourthly, the Examiner provided the Tsumura reference to teach the "animation" feature that is not taught by Miller.

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For all the reasons given above, the Examiner posits that Applicant's arguments are not persuasive.

b) Applicant argues that "*Tsumura et al. does not disclose \"based on the determining...animated image.\" While Tsumura et al. discloses displaying a stored animated image such image is not for a \"selected program\" having \"audio-only content\" since \"karaoke\", the field of endeavor disclosed in Tsumura et al., has a visual content associated therewith*" on page 8, lines 20-27 of the amendment filed 5/30/2003.

In response to applicant's argument with respect to Tsumura, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Further, Miller discloses playing of still image(s) when an audio-only content is being played. The Tsumura reference was cited by the Examiner to teach that animation provides better enjoyment over still images when audio is being played. See Tsumura at col. 1, lines 36-46.

Since substituting still image(s) for animation provides visual enjoyment, the Examiner posits that the combined teachings Miller and Tsumura disclose all the claimed limitations and as a result, Applicant's arguments are not persuasive.

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5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

6. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____.

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(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) _____ - _____ on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Grant whose telephone number is (703) 305 4755.

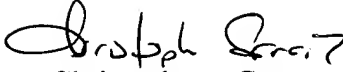
The examiner can normally be reached on Monday-Friday 8:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872 9314 for regular communications and (703) 872 9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

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Christopher Grant
Primary Examiner
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CG
August 22, 2003